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08/30/2007

EXAMINER

WOO, STELLA L

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/134,831
Filing Date: August 17, 1998
Appellant: METTKE, RICHARD P.

Richard P. Mettke
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed July 3, 2007 appealing from the Office action mailed February 23, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No. 2006-0625 for Reissue Application 09/134,831, examiner affirmed and new grounds of rejection entered in Decision mailed August 31, 2006.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct in part. Although the summary does not refer to the specification by page and line number and to the drawings, Appellant states that the revised Appeal Brief filed July 3, 2007 complies with the provisions of 37 CFR 41.37©(1)(v). The second paragraph of the summary starting with "Users can publicly access..." includes arguments and opinions made by Appellant, not a concise explanation of the claimed subject matter defined in claim 6.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Appellant's brief presents arguments relating to whether new matter was introduced into the drawings and specification. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Claim 6 is not rejected on the grounds of res judicata.

(7) Claims Appendix

A substantially correct copy of appealed claim 6 appears on page 30 of the Appendix to the appellant's brief. The minor errors are as follows:

In claim 6, line 1, "comprising a" should be changed to --comprising--.

In claim 6, lines 5-6, the phrase "for use of the terminal or other activity" should be deleted.

(8) Evidence Relied Upon

Weiner, Allen, "TouchFax Provides the Ultimate in Place-Based Interactivity" Interactive World (October 1992), pp. 48-49, (Exhibit E to TouchNet Protest).

"Vision, Power, Versatility" brochure, TouchFax Information Systems, Inc. (1991), (Exhibit F to TouchNet Protest).

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Shah, Rawn, "Suggestions for Information Kiosk Systems using the World Wide Web," <http://www.rtd.com/people/rawn/kiosk-paper.html> (April 30, 1994), pp. 1-5 (Exhibit I to Protest by North Communications, Inc.).

TOUCHFAX AMERICA, video tape recorded May 14, 1993, and distributed by TouchFax Information Services as advertising at the May 1993 Comdex in Atlanta, Georgia, 1993 (Exhibit C to TouchNet Protest) (Artifact No. 09134831VA), including six printouts of frames from the video tape (Exhibit C, 1 to Exhibit C, 6) (Artifact No. 09134831CA).

TouchFax Network Topography Diagram, 1991, Touch Fax Information Systems, Inc. (Exhibit D to TouchNet Protest).

Landis & Gyr, ISDN console, Public telephone and telematic console, available in 1988 (Exhibit C to Protest of Griffes Consulting SA) (hereinafter "L&G ISDN console").

Gilster, Paul, The Internet Navigator (2d ed. John Wiley & Sons, Inc. 1994), pp. 15-18, 24, 25, 56, 57, 195, 221-225 (hereinafter "Internet Navigator").

Cantor, Adrew, "Aliens Among Us," Internet World, Nov/Dec 1994, pp. cover, index (2 pages), 82-84 (hereinafter "Aliens").

"On Haiti, Shooting from the Lip," Washington Post, October 6, 1994, from Lexis/Nexis (hereinafter "On Haiti").

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

(A) Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the article by Allen Weiner, entitled "TouchFax Provides the Ultimate in Place-Based

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Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of the TouchFax brochure entitled "Vision, Power, Versatility" (submitted as Exhibit F in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit F"), and further in view of an article by Rawn Shah entitled "Suggestions for Information Kiosk Systems using the World Wide Web", submitted with the Protest by North Communications, Inc. as Exhibit I (hereinafter "the Shah article") for essentially the same reasons given in the final Office action mailed February 23, 2007 and the Examiner's Answer mailed August 17, 2005, and affirmed by the BPAI Decision mailed August 31, 2006.

Exhibit E discloses a public on-line terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising:

- a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

- a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

- a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

- a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);

- means for accessing and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph); and

a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

Exhibit E differs from claim 6 in that it does not *explicitly* recite software installed into the CPU to allow interaction with credit card centers. However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the credit card centers in order to authorize payments made via the credit card reader.

The combination of Exhibits E and F differs from claim 6 in that it does not specify accessing and interfacing with the Internet. However, the combination does allow for accessing and interfacing with a remote service provider via a modem and the Shah article teaches the desirability of providing access to and interaction with the Internet in a kiosk-based information system (pages 1-2, section entitled "The Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to provide users with access to the many services on the Internet including a paid service by commercial organizations which charges customers for access to specific services (page 2, section entitled "Who will use these systems?" and page 5, lines 11-12). It would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information

system, as taught by the Shah article, within the combination of Exhibits E and F in order to provide users with access to the many services available on the Internet.

(B) Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Exhibit C (including Exhibits C, 1 to C, 6), Exhibit D, Exhibit E, Exhibit F, L&G ISDN console, Internet Navigator, Aliens, and On Haiti, for the reasons given in the BPAI Decision mailed August 31, 2006 (see Decision, pages 42-58).

(10) Response to Argument

(A) In the final Office action mailed February 23, 2007, Figure 2 was objected to as introducing new matter. Appellant argues that substitute Figure 2 was submitted based on the examiner's direction in the Office action dated April 27, 1995. However, the original Figure 2 did not show the components arranged in a unitary housing as in the substitute Figure 2, and the original specification does not describe the components being incorporated within a unitary housing. Moreover, the examiner's direction referred to by the Appellant did not direct the Appellant to show a housing.

(B) In the final Office action mailed February 23, 2007, the examiner required that new matter introduced into the disclosure of the invention be cancelled, namely, the new matter at col. 2, lines 3-7; col. 2, line 53 – col. 3, line 3. Appellant argues that the new matter was deleted in an Amendment dated May 29, 2002. However, this After-Final Amendment filed June 3, 2002 was not entered (see Advisory Action mailed June 25, 2002) because it did not cancel the new matter at col. 2, lines 3-7.

© Appellant argues that the BPAI should "not be allowed to bring in references or make decisions based on expertise or experience." However, under 37

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CFR 41.50(b), "the Board may, in its decision, make a new rejection of one or more of any of the claims pending in the case" (see MPEP 1213.02).

Appellant argues that Exhibit C is a videotape which "is clearly a concept, experimental, an idea and marketing tool" and "[t]his alone should have negated it [sic] use as prior art or use as rendering the applicants [sic] claims as obvious." However, the rejection was based on a **combination** of references (Exhibit C (including Exhibits C, 1 to C, 6), Exhibit D, Exhibit E, Exhibit F, L&G ISDN console, Internet Navigator, Aliens, and On Haiti).

Exhibit C is a videotape including a printout of a video frame (Exhibit C, 3) which specifically advertises connection to the Prodigy Information Service, a well-known online computer service provider in 1993, and a printout of a video frame (Exhibit C, 4) which specifically advertises connection to the Internet. The Internet Navigator describes that the Internet is a network of networks, which is made from computers and cables (p. 15) and provides many different applications or services, such as e-mail, file transfer, remote login (pp. 24-25). Commercial online services, such as CompuServe, were centralized as opposed to distributed like the Internet (pp. 17-18). "[C]ommercial providers such as CompuServe, GENie, and Prodigy have all made Internet mail access available" (p.16; see also, pp. 57, 195; e-mail at pp. 221-225). Thus, many online service providers, such as Prodigy, provided access to the Internet via e-mail. Claim 6 recites access to the Internet and is met by access to one service on the Internet, such as e-mail. Further, Aliens describes that online service providers such as America Online, CompuServer, GENie, and Prodigy were providing access to more features of

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the Internet in 1994, such as an e-mail gateway to and from the Internet (see pp. 83-84).

Appellant argues that there is not motivation to combine Exhibits C, D, E, and F. As stated in the Decision mailed August 31, 2006, [t]he motivation to combine any of the teachings of TouchFax Exhibits C, D, E, and F is that all exhibits are from the same corporation, TouchFax, and expressly teach modifications, variations, and improvements to a pay-for-use public communications terminal. Thus, the teaching of Internet access in Exhibit C suggests modifying Exhibits E and F to provide Internet access, and the teaching on providing access to online service providers in Exhibit D suggests modifying Exhibits E and F to provide access to online service providers." As expressly stated in Internet Navigator and Aliens, access to the Internet, at least to e-mail services on the Internet, was commonplace in 1994 and was provided by online service providers, such as CompuServe and Prodigy. Therefore, any access to online service providers in 1994 would have provided access to the Internet.

Appellant argues that the references do not teach interfacing with the Internet. However, connection with the Internet via e-mail services can be considered as an "interface with the Internet" in that the e-mail service provider provides a connection point between the terminal and the Internet.

Appellant argues that the references (Exhibits C, D, E, F, L&G ISDN console) are not within the field of endeavor to the matter at hand and states that "[t]he BPAI use of Public Communications terminal is too broad as a field of endeavor." However, as stated on page 43 of the Decision mailed August 31, 2006, "Exhibits C, D, E, F, L&G

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ISDN console, and On Haiti relate to pay-for-use public communications terminals and are within the inventor's field of endeavor. The Internet Navigator and Aliens relate to on-line service providers and access to the Internet and are reasonably pertinent to the problem of providing Internet access."

(D) Appellant argues that Shah teaches using a "web style browser" and teaches away from accessing the Internet. However, Shah does not describe a "web style browser." On page 2 of the article, Shah clearly states that "the Web is part of the Internet" and "allows users access to the many services on the Internet" (line 4). On page 2, under the section titled "The Access Interface," Shah describes the Access Interface as including a "Web Browser," not a *web style* browser, as asserted by Appellant.

Appellant further argues that "the Shah abstract does not teach accessing the Internet." Again, on page 2, Shah clearly states that "the Web is part of the Internet" and "allows users access to the many services on the Internet" (line 4). This Internet access is given as one of many reasons why the Web is ideally suited for the kiosk system application (see pp. 1-2). Clearly, access to the Internet through the World Wide Web would not be given as a reason why the Web is ideally suited for the kiosk application if the kiosk system, as the Appellant asserts, lacks access to the Internet. Under the section titled "Who will use these systems?" Shah describes use by commercial and non-commercial organizations in the World Wide Web. Regarding the section titled "The Server" on page 3, Shah states that each kiosk *may* be a standalone system containing all the local information and with a link to the rest of the network via a

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permanent, non-permanent or dial-up connection. Moreover, each of the references cited on page 5 of the article relates to communication over the Internet.

(E) Appellant argues that "additional indicia of nonobviousness relating to this reissue action should be considered and addressed by the BPAI." However, these arguments were considered and addressed on pages 37-40 of the Decision mailed August 31, 2006.

(11) Related Proceedings Appendix

A copy of the Board decision identified in the Related Appeals and Interferences section of this examiner's answer is provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Stella Woo

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